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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,893	06/09/1999	JORG SCHABERNACK	Q54532	7430

7590

04/01/2003

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EXAMINER

DUONG, OANH L

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 04/01/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/328,893

Applicant(s)

SCHABERNACK ET AL.

Examiner

Oanh L. Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1-10 are presented for examination.

1. Applicant's arguments filed on January 22, 2003 have been fully considered but they are not persuasive.

Response to Arguments

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reason to connect the network device (computer system) to SDH (Synchronous Digital Hierarchy) network is to allow data transmission to and from network device at different bit rates to be carried and data can be transmitted digitally (the natural form for computer data) rather than analogically.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (Bennett) (USPN 5,189,733) in view of Mishra (USPN 6,339,587).

Regarding claim 1, Bennett discloses a method comprising steps of checking in response to a request for access to one of a plurality of managed objects whether this requested object is stored in the memory of a network element (see col. 7 lines 6-9); if this requested object is not stored in the memory, checking whether there is sufficient memory space to write this object into the memory (see col. 7 lines 9-13); if there is no sufficient memory space, swapping at least one of the stored objects out of the memory to a database according to at least one predeterminable criterion (see col. 7 lines 13-18); and reading the requested object from the database and writing it into the memory (see col. 7 lines 18-24). Bennett does not disclose a Synchronous Digital Hierarchy network as claimed. However, Mishra discloses a Synchronous Digital Hierarchy network (SDH network 91) (see cols. 5-6 lines 52-65). Therefore, it would have been obvious to have used the Synchronous Digital Hierarchy network in Bennett as taught by Mishra because it not only allows transmission at variable bit rates to be carried, but allows individual signals to be added or extracted without demultiplexing other signal multiplexed with it.

Regarding claim 2, Bennett discloses the objects which are accessed most frequently remain in the memory (see col. 7 lines 16-18).

Regarding claim 3, Bennett discloses a predeterminable number of recently accessed objects remain in the memory (see abstract).

Regarding claim 5, Bennett discloses the predeterminable criterion is a length of time which indicates how long each of the objects may remain stored in the memory (see col. 2 lines 12-18).

Regarding claim 6, Bennett discloses the predeterminable criterion is a maximum number which indicates how many objects may remain stored in the memory (see col. 4 lines 3-6).

Regarding claims 7 and 9, Bennett discloses a network element comprising a controller (see fig. 1B) for managing the network element using managed objects, a memory (see col. 4 line 9) connected to the controller, and a database connected to the controller, wherein the controller, in response to requests, manages the network element by accessing the memory and using the objects stored therein (see fig. 9), wherein in response to a request for access to one of the managed objects, the controller checks whether this requested object is stored in the memory (see col. 7 lines 6-9), wherein, if this requested object is not stored in the memory, the controller checks whether there is sufficient memory space to write this object into the memory (see col. 7 lines 9-13), wherein, if there is no sufficient memory space, the controller causes at least one of the stored objects to be swapped out of the memory to a database according to at least one predeterminable criterion (see col. 7 lines 13-18), and wherein the controller reads the requested object from the database and writes it into the memory (see col. 7 lines 18-24). Bennett does not disclose a Synchronous Digital Hierarchy network as claimed. However, Mishra discloses a Synchronous Digital Hierarchy network (SDH network 91) (see cols. 5-6 lines 52-65). Therefore, it would

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have been obvious to have used the Synchronous Digital Hierarchy network in Bennett as taught by Mishra because it not only allows transmission at variable bit rates to be carried, but allows individual signals to be added or extracted without demultiplexing other signal multiplexed with it.

Regarding claim 8, Bennett discloses the memory is a semiconductor memory, and wherein the database is implemented on a nonvolatile mass storage, particularly on a hard disk (see col. 7 lines 20-24).

Regarding claim 10, Bennett does not teach the network element as claimed. However, Mishra teaches at least one of crossconnects, add-drop multiplexers, and line multiplexer (see col. 6 lines 7-10). Therefore, it would have been obvious to have used the element in Bennett as taught by Mishra because it would add or extract signals as required so as to satisfy the request.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Mishra in further view of Finni (USPN 5,941,978).

Regarding claim 4, the combination of teachings of Bennett and Mishra does not teach CMISE filter as claimed. However, Finni teaches the predeterminable criterion is a filter function, particularly a CMISE filter function, which indicates which objects are to remain stored in the memory (see col. 1 lines 36-63 and col. 4 lines 14-44). Therefore, it would have been obvious to have used the CMISE filter function in the combination of teachings Bennett and Mishra as taught by Finni because it enables the network management system to select a target group for CMIP management operation applied to a network element of a communication network.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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O.D

March 24, 2003



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